Atty's Docket: 101198-3
USSN 09/752,957
David SHIUAN

REMARKS

Claims 1-16 are pending in this application.

The Examiner has issued a three-way restriction requirement in this case.

Claim 8 has been amended to unambiguously require that the method of preparing the yeast requires the plasmid of group I. No new matter is introduced by the amendment. As discussed below, amended claim 8 links Groups I, II and III in a manner sufficient traverse the restriction requirement.

ELECTION

In response to the restriction requirement, Applicants provisionally elect GROUP II with traverse.

Group II comprises claims 8-14, and is drawn to a method for preparing the yeast.

SPECIES

In view of the provisional election of GROUP II that does not include claim 7, the election of species is moot.

However, should the arguments in support of traversing the restriction be persuasive, thus necessitating the election of species, the Applicants provisionally elect

species of claim 7 (a), pMCC21, having the configuration of restriction sites in Figure 6.

ARGUMENTS IN SUPPORT OF TRAVERSAL

Groups I and II

Examiner's rationale for restricting Groups I and II, is based on their being patentably distinct and because examining them together would requir a burdensome search due to different classifications. Respectfully, neither is accurat .

The invention of Group I is a yeast expression plasmid, and that of Group II is a method of preparing yeast that contain this specific plasmid. Please see amended claim 8. Therefore, a search of a yeast expression plasmid will necessarily bring up references to the yeast expressing it and how the yeast were transformed. This is especially true because the claims in Group II now specifically require that the yeast express the plasmid of Group I.

In order for a prior art search Groups I and II to be burdensome requires that it is customary in the art to publish articles or submit patent applications only describing a plasmid and only a method of making the yeast that express it. This is simply not done in this art. It is not newsworthy or inventive to describe only a plasmid, without its utility or an enabling description of its use and method of preparation or evidence that it does what it is was created to do.

This is true for scientific articles as well as patent applications and issued patents. The undersigned has yet to examine a reference disclosing only a plasmid wherein the reference did not also disclose the method of making and the method of using.

The natural connection between Groups I and II are further illustrated by Examiner's example of a "patentably distinct method" for which the plasmid may be used – "*...such as methods to overexpress the encoded enzyme, biotin synthase.*" See office action, page 2. Examiner's example simply re-states a major aspect of the method of Group II, claim 8 – transforming yeast with the plasmid of Group I to obtain yeast with high biotin productivity. Persons of ordinary skill in the art clearly understand that overexpressing the enzyme in yeast is at least one major result of performing the claims of Group II.

In accordance, Applicants respectfully request that the restriction requirement relating to Groups I and II be withdrawn. Further, Groups I and II should be examined together, as the plasmid of Group I cannot be employed in another patentably distinct process.

Groups I and III

The same arguments as above can be applied with equal force to withdrawing the restriction between groups I and III.

It is virtually unimaginabl that references describing the synthesis of biotin by transformed yeast would not also disclose the plasmid that was introduced into said yeast.

Respectfully, Groups I and III should also be examined.

Groups II and III

The restriction between groups II and III is improper. The claims of Group II are drawn to a method of preparing yeast having a high capacity for biotin production. Thus, searching the prior art for methods of using transformed yeast to produce biotin will necessarily bring up references on how the yeast were made.

In both scientific publications as well as patent applications, finding a method of using transformed yeast to prepare biotin almost always includes data, protocols etc, relating to methods of making the yeast. Otherwise, the reference would disclose, e.g., only incubating yeast in a vessel and collecting the biotin. By itself, this is not likely to be considered newsworthy or inventive subject matter.

Therefore, because the methods would certainly be disclosed together in most references, the search cannot be viewed as being sufficiently burdensome to warrant restriction.

It is respectfully requested that Groups II and III be examined together.

Respectfully Submitted,

Norris, McLaughlin & Marcus
220 East 42nd Street
New York, NY 10017
Telephone (212) 808-0700
Facsimile (212) 808-0844

Theodore Gottlieb, PhD
Reg. Nr. 42,597

MARK UP OF AMENDED CLAIMS

8. A method for preparing yeast with high biotin productivity, wherein the yeast comprises the integrated plasmid of claim 1, the method comprising the steps of:

constructing ~~an~~ the integrated plasmid of claim 1 ~~comprising a biotin synthase gene, an assistant DNA sequence for the integration of said plasmid into a host genome, a promoter sequence, and a selection marker;~~

linearizing said integrated plasmid; and

transforming said linearized integrated plasmid into a yeast under conditions that permit recombination between ~~recombining~~ the biotin synthase gene and ~~with~~ the yeast genome.

FAX COVER SHEET

NORRIS, MCLAUGHLIN & MARCUS
220 East 42nd Street
New York, NY 10017
facsimile (212) 808-0844
telephone (212) 808-0700

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTENTION	Kathleen Kerr
ART UNIT	1652
FAX NUMBER	703 872 9306
TOTAL PAGES (Plus Fax Cover)	8

SERIAL NO.	:	09/752,957
APPLICANT	:	David SHIUAN
FILED	:	January 2, 2001
EXAMINER	:	Kathleen Kerr
ART UNIT	:	1652
FOR	:	YEAST WITH HIGH BIOTIN-PRODUCTIVITY AND THE PREPARATION METHOD THEREOF

MESSAGE

April 25, 2003

Attached please find:

- Response to Restriction Requirement

Respectfully submitted,

Theodore Gottlieb, PhD
Registration Number 42,597